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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/699,765 | 11/03/2003 | John Gandy | 20509.023 | 4233 |

42922 7590 05/25/2006

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| EXAMINER | |
|---|---|
| ZIMMERMAN, JOHN J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1775 | |

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/699,765 | GANDY, JOHN | |
| | Examiner | Art Unit | |
| | John J. Zimmerman | 1775 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *10,13,14,16 and 21-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10, 13-14, 16 and 21-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *8/31/05* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

# OFFICE ACTION

### *Amendments and Remarks*

1. This Office Action is in response to the "AMENDMENT" received March 9, 2006. Claims 10, 13-14, 16 and 21-28 are pending in this application. A new search of the claimed subject matter has resulted in the discovery of prior art references that are relevant to the patentability of the pending claims. Since the new rejections, below, were not necessitated by applicant's amendments to the claims, this Office Action has not been made Final.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. It is not clear whether the term "greater" (claim 21, line 2) refers to "about 2" or refers to the range "about 2 to 6".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 10, 13-14, 16 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyooka (U.S. Patent Application Publication 2003/0057695 A1) in view of Hirasawa (U.S. Patent Application Publication 2003/0188813).

7. Toyooka discloses a method of manufacturing a seam welded pipe formed from stainless steel wherein the carbon content is preferably in the range of 0.003 to 0.15 wt.% (e.g. see paragraph [0016]), with the carbon content in the examples at less than 0.080 wt.% (e.g. see TABLE 1), and with the chromium content in the range of 10-18 wt.% (e.g. see paragraph [0022]), with chromium content in the examples at 11, 11.5 and 12.9 wt.% (e.g. see paragraph [0052] and TABLE 1), and with a molybdenum content up to 2.5 wt.% (e.g. see paragraph [0029]). The carbon and chromium contents of Toyooka's examples fall directly in applicant's ranges and in any event, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549. The stainless steel can be a dual (ferrite plus martensite) stainless steel (e.g. see paragraph [0008], [0062]). Toyooka

differs from the claims in that while Toyooka discloses that seam welding can be performed using high frequency electric resistance welding (e.g. see paragraph [0013]), Toyooka may not specify high frequency induction welding. Hirasawa, however, clearly shows that high frequency induction welding is considered an obvious high-frequency resistance welding process for seam welding stainless steel piping (e.g. see paragraph [0070]). Of particular note, Hirasawa clearly indicates the use of high frequency induction welding with stainless steel piping with less than 0.008 wt.% carbon (e.g. see paragraph [0028]) and 11-15 wt.% chromium (e.g. see paragraph [0033]). In view of Hirasawa, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use high frequency induction welding for the seam welded stainless steel piping of Toyooka because Hirasawa clearly shows that high frequency induction welding is an art recognized obvious alternative seam welding process for stainless steel piping of similar carbon and chromium content as the stainless steels of Toyooka. Toyooka may not specify the chemical balance of the stainless steel as determined by the Kaltenhauser Factor (e.g. see applicant's claims 16 and 27), but Toyooka's compositions fall within applicant's claimed ranges and therefore would be expected to have the same properties. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431

(CCPA 1977). Regarding claims 21 and 22, although Toyooka may not require pipe outside diameters of greater than about 2-6 inches and greater than about 12 inches, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pipe bodies of Toyooka in any reasonable diameters that would have commercial uses in order for Toyooka's pipes to be economically viable products. Regarding claim 14, one of ordinary skill in the metallurgical art would readily understand that weld bond lines should be relatively free of oxides. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do standard ultrasonic and/or electromagnetic inspection processes on the seam welded pipes of Toyooka since these types of inspection processes are typically required in the art to locate welding defects before welded pipes are used. In addition, although Toyooka may not specify details in selecting finished plate or coil and passing it through a continuous forming mill to form the seam welded pipes, it must be assumed that one of ordinary skill in the art understands basic welded pipe manufacturing steps, testing procedures and inspection procedures.

***Response to Arguments***

8. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground of rejection. The rejections from the prior Office Action have been withdrawn in favor of the current rejection. Since the new rejection under 35 U.S.C. 103(a) applying Toyooka (U.S. Patent Application Publication 2003/0057695 A1) in view of Hirasawa (U.S. Patent Application Publication 2003/0188813) was not necessitated by applicant's amendments to the claims, this Office Action has not been made Final.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited prior art serves to further establish the level of ordinary skill in the art at the time the invention was made.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
May 23, 2006